



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DW Nov-08

ZAGORIN O'BRIEN GRAHAM LLP
7600B NORTH CAPITAL OF TEXAS HIGHWAY
SUITE 350
AUSTIN TX 78731

COPY MAILED

NOV 20 2008

In re Application of	:	
Bandini et al.	:	
Application Number: 10/678583	:	ON PETITION
Filing Date: 10/02/2003	:	
Attorney Docket Number: 127-	:	
0008-4	:	

This is a decision on the petition to withdraw the holding of abandonment filed on October 24, 2008.

This application was held abandoned for failure to timely respond to the final Office action mailed on April 2, 2008, which set a three (3)-month shortened period for reply. Notice of Abandonment was mailed on October 30, 2008. On October 24, 2008, the subject petition was filed.

Petitioners request that the Office withdraw the holding of abandonment due to non-receipt of the final Office action mailed on April 2, 2008. In support of the allegation that the Notice to final Office action mailed on April 2, 2008 was never received, petitioners have submitted a copy of counsel's docket record and mail log, and have provided a statement by registered patent practitioner David W. O'Brien, stating that a search of the file jacket and docket records indicates that the Office communication was not received. The docket report and mail log are referenced in counsel's statement.

A review of the record indicates no irregularity in the mailing of the final Office action mailed on April 2, 2008, and in the absence of any irregularity in the mailing, there is a strong presumption that the final Office action mailed on April 2, 2008, was properly mailed to the address of record. This presumption may be overcome by a showing that the final Office action mailed on April 2, 2008 was not in fact received.

MPEP 711.03(c) states, in pertinent part:

In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted

as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

Accordingly, there was no abandonment in fact. The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

The petition is **GRANTED**.

The application is being referred to the Technology Center technical support staff for remailing of the final Office action mailed on April 2, 2008. The period for reply will be reset from the mailing date thereof.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions